

REMARKS

Claims 1-24 are pending. By this Amendment, Applicants amend Figure 2A and the specification and add claims 25 and 26.

Applicants appreciate the courtesies shown to Applicants' representative by Examiner Edouard in the December 10, 2003 personal interview. Applicants' incorporate their separate record of the substance of the interview into the following remarks.

The Office Action rejects claims 1-24 under 35 U.S.C. §112, first paragraph, for lack of enablement. Applicants respectfully traverse the rejection.

As discussed during the December 10 personal interview, in establishing a disclosure, Applicants may rely, not only on the description and drawing as filed, but also on the original claims (MPEP §§608.01(I) and 608.04). Because, each of claims 1-24 is an original claim, it is part of the disclosure under MPEP §§608.01(I) and 608.04. Thus, claims 1-24 are self-enabling.

Furthermore, according to MPEP §2164.01 the test for enablement under 35 U.S.C. §112, first paragraph, is whether any person skilled in the art can make and use the invention without undue experimentation. As discussed at the December 10 personal interview, Applicants' specification repeatedly discloses that a plurality of theories of discourse analysis may be used with the disclosed invention (page 4, lines 29-33; page 6, lines 22-26; page 7, lines 11-14; page 8, lines 24-28; page 10, lines 10-11; page 13, lines 4-7; page 16, lines 24-28). Furthermore, self-enabled claims 1-24 specifically recite selecting a discourse theory. As such, there can be no doubt that any person skilled in the art would understand without any experimentation that one of the theories must first be selected prior to segmenting and analyzing the text.

Because, under MPEP §608.01(I) and 608.04, claims 1-24 constitute part of the disclosure and any person skilled in the art would understand from the disclosure that

selecting a theory of discourse analysis is necessary prior to segmenting and analyzing the text, claims 1-24 are enabled under 35 U.S.C. §112, first paragraph. As a result, Applicants respectfully request that the rejection be withdrawn.

The Office Action rejects claims 1-24 under 35 U.S.C. §112, second paragraph, as being indefinite. Applicants respectfully traverse the rejection.

First, the Office Action alleges that claims 1-24 are indefinite because the specification does not describe the step of selecting a theory of discourse analysis. Applicants note that this is improper grounds for an indefiniteness rejection under 35 U.S.C. §112, second paragraph. "If the claim is too broad because it is not supported by the original description or by an enabling disclosure, a rejection under 35 U.S.C. §112, first paragraph would be appropriate" (MPEP §2173.04) not a rejection under 35 U.S.C. §112, second paragraph. Because an alleged lack of written description is properly rejected under 35 U.S.C. §112, first paragraph, rather than 35 U.S.C. §112, second paragraph, and Applicants have addressed 35 U.S.C. § 112, first paragraph, above, Applicants respectfully request that the rejection be withdrawn.

Second, the Office Action alleges that claims 1-24 are indefinite because the feature "selecting a theory of discourse analysis for teaching writing" does not set the meets and bounds of the claims. As agreed upon during the April 22, 2003 personal interview, and represented during the December 10 interview, the step of selecting a theory of discourse analysis requires that there be a plurality of discourse theories. "Select" is commonly defined as "to take as a choice from among several."¹ It is explicit in this definition that selecting requires that there be plurality of discourse theories. Therefore, as agreed upon during the April 22, 2003 personal interview, it is impossible to select a theory of discourse analysis

¹ The American Heritage College Dictionary, 3rd edition, page 1235.

when there is only a single theory. Because selecting a theory of discourse analysis explicitly requires that there be a plurality of discourse theories, Applicants respectfully request that the rejection be withdrawn.

The Office Action objects to the drawings under 37 C.F.R §1.83(a). By this Amendment, and as discussed during the December 10 personal interview, Applicants amend Figure 2A to include the step of selecting a theory of discourse analysis. Furthermore, Applicants amend the specification is amended to describe the additional step. No new matter has been added since selecting a theory of discourse analysis was recited in original claims 1-24 and constitutes part of the original disclosure under MPEP §§608.01(l) and 608.04. As a result, Applicants respectfully request that the objection be withdrawn.

The Office Action rejects claims 1-3, 8-9, and 12-13 under 35 U.S.C. §102(e) over U.S. Patent 6,112,168 to Corston et al. (hereinafter "Corston"). Applicants respectfully traverse the rejection.

As agreed during the April 22, 2003 personal interview, Corston fails to teach or describe a step of "selecting a theory of discourse analysis for teaching writing," as recited in claims 1-3, 8-9, and 12-13. During the December 10 personal interview Examiner Edouard indicated that he had maintained this rejection on the grounds that a selecting step might be inherent in the method of Corston. As discussed during the December 10 personal interview, a selecting step cannot be inherent in the method of Corston. "Select" is commonly defined as "to take as a choice from among several." It is explicit in this definition that selecting requires that there be plurality of discourse theories. Corston does not disclose more than a single discourse theory, and, as such, there cannot be a step of selecting inherent in the method disclosed in Corston.

Because, Corston fails to teach or describe a step of "selecting a theory of discourse analysis of teaching writing," as recited in claims 1-3, 8-9, and 12-13, claims 1-3, 8-9, and 12-

13 are patentable over Corston. As a result, Applicants respectfully request that the rejection be withdrawn.

The Office Action rejects claims 4-6, 10, 11, 16-18, 20, and 22-24, under 35 U.S.C. §103(a) over Corston in view of U.S. Patent 5,642,520 to Takeshita et al. (hereinafter "Takeshita"). Applicants respectfully traverse the rejection.

The rejection is premised upon the presumption that Corston discloses each of the features of claim 1. Because, as discussed above Corston fails to teach or describe a step of "selecting a theory of discourse analysis of teaching writing," the rejection is moot. As a result, Applicants respectfully request that the rejection be withdrawn.

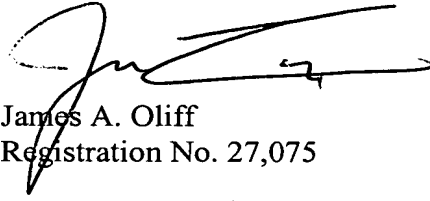
Finally, Applicants add claims 25 and 26 to further describe the invention. Support for claims 25 and 26 may be found at least on page 13, lines 6 - 7 and page 5, line 11 - page 11, line 28, respectively.

During the December 10 personal interview Examiner Edouard indicated that the arguments presented during the December 10 personal interview and incorporated into the above remarks, would most likely overcome the outstanding objection and rejections. However, Examiner Edouard indicated that, in light of the fact that had only recently been transferred this application, he would like the opportunity to review the arguments and references before formally withdrawing the objection and rejections.

In view of the foregoing, Applicants respectfully submit that this application is in condition for allowance. Applicants earnestly solicit favorable reconsideration and prompt allowance of claims 1-24.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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